

REMARKS

Revocation of Power of Attorney

Applicant is enclosing herewith a Revocation of Power of Attorney and Appointment of New Attorney naming BRUCE H. TROXELL as attorney of record in this patent application. It is requested that all further correspondence regarding this matter be forwarded to TROXELL LAW OFFICE PLLC at the address listed on the enclosed form. A CHANGE OF ADDRESS FORM is also being submitted herewith.

Claim Rejections

Claims 1, 3 and 4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yasuhiro (JP-2001-320461). Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuhiro. Claim 2 is rejected under 35 U.S.C. § 103(g) as being unpatentable over Yasuhiro in view of Fan (U.S. 5,592,066).

Drawings

The drawings were objected to under 37 C.F.R. § 1.83(a) insofar as the battery charger is not shown in the figures. Applicant is submitting herewith an amended formal drawing of Figure 4, accompanied by a Letter to the Official Draftsperson, adding reference numeral --33--. No "new matter" has been added to the original disclosure by the amendment to this figure. It is believed that the foregoing amendments obviate the outstanding objections to the drawings. Entry of the corrected drawing is respectfully requested.

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, excepted as discussed above, Applicant must assume that the drawings are acceptable as filed.

New Claims

By this Amendment, Applicant has canceled claims 1-5 and has added new claims 6-10 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and

define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a mobile phone assembly comprising: a mobile phone (1) having a camera lens (10) and transmitting pictures; and an embedding base (2) removably connected to the mobile phone and having an illumination device (3) having: at least one lamp (32) producing an illumination in a photographing direction for the camera; and a switch (30) controlling a battery selectively supplying power to the at least one lamp.

Other embodiments of the present invention include: the at least one lamp includes two lamps; the battery is located in the phone, and the illumination device is connected to the battery through a circuit; the battery (31) is located in the embedding base; and the illumination device includes a circuit electrically coupled to a battery charger (33) charging the battery.

The cited reference to Yasuhiro teaches a mobile phone (1) having a camera lens (5), a switch (41), and a lamp (3).

Yasuhiro does not teach an embedding base removably connected to the mobile phone; the embedding base having an illumination device having at least one lamp producing an illumination in a photographing direction for the camera, and a switch controlling a battery selectively supplying power to the at least one lamp; the at least one lamp includes two lamps; the battery is located in the phone, and the illumination device is connected to the battery through a circuit; the battery is located in the embedding base; nor does Yasuhiro teach the illumination device includes a circuit electrically coupled to a battery charger charging the battery.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Yasuhiro does not disclose each and every feature of Applicant's new claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Yasuhiro cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

The secondary reference to Fan teaches a mobile phone recharger (1) having a battery seat (11), a light source (12), and a switch (13).

Fan does not teach a embedding base removably connected to the mobile phone; the at least one lamp includes two lamps; the battery is located in the phone, and the illumination device is connected to the battery through a circuit; nor does Fan teach the battery is located in the embedding base.

Even if the teachings of Yasuhiro and Fan were combined, as suggested by the Examiner, the resultant combination does not suggest: a embedding base removably connected to the mobile phone; the at least one lamp includes two lamps; the battery is located in the phone, and the illumination device is connected to the battery through a circuit; nor does the combination suggest the battery is located in the embedding base.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Yasuhiro or Fan that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Yasuhiro nor Fan disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: June 29, 2005

By: _____


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Application No. 10/736,101

IN THE DRAWINGS:

Please amend Figure 4 as illustrated in the attached formal drawing, accompanied by a Letter to the Official Draftsperson.